

### **REMARKS**

In view of the above amendment, Applicant believes the pending application is in condition for allowance. Claims 1, 2, 6-13, and 15 are now present, of which claims 1, 8, and 10 are independent. By this amendment, the specification has been amended, claims 3-5 and 14 have been canceled, without prejudice or disclaimer, and claims 1, 6, 7, 13, and 14 have been amended.

Reconsideration of this application, as amended, is respectfully requested.

### **Priority Under 35 U.S.C. § 119**

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority documents.

### **Information Disclosure Citation**

Each of the two Information Disclosure Statements filed by Applicant to date has been considered by the Examiner, and initialed PTO-SB08 forms have been provided by the Examiner. Therefore, no outstanding issues remain with respect to the consideration of Information Disclosure Statements.

### **Drawings**

Applicant thanks the Examiner for indicating that the drawings are accepted.

### **Restriction Requirement**

The Examiner has acknowledged the Restriction Requirement, and has withdrawn claims 8-13 and 15 from consideration.

### **Claim Objections**

The Examiner has objected to claims 7 and 14 because "coloidal" should be spelled "colloidal". In order to overcome this objection, Applicant has amended claim 7 in order to correct the deficiency pointed out by the Examiner. In addition, the specification and withdrawn

claims 13 and 15 have also been amended to correct this deficiency. Reconsideration and withdrawal of this objection are respectfully requested.

**Rejection Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

Claims 1-7 and 14 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language is not clearly understood.

In order to overcome this rejection, Applicant has amended claim 1 to correct each of the deficiencies specifically pointed out by the Examiner. Applicant respectfully submits that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

**Obviousness-Type Double Patenting Rejection**

Claims 1, 3, and 7 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending U.S. Patent Application No. 10/592,124 in view of Strange or Hattori. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicant notes that independent claim 1 has been amended to recite at least some of the subject matter of canceled claims 4 and 5, which were not provisionally rejected. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

**Rejection Under 35 U.S.C. §§ 102 and 103**

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Strange; claims 4 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Strange in view of Hattori;

claims 5 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Strange and Hattori in further view of Ishihara; and claims 1-7 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ishihara in view of Strange. These rejections are respectfully traversed.

Complete discussions of the Examiner's rejections are set forth in the Office Action, and are not being repeated here.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicant respectfully submits that independent claim 1, has been amended to recite a combination of elements in a briquette for use as a steelmaking material including "a dry briquette which contains a ferrous metal and which is formed by solidifying shot waste with a solidification assistant, the shot waste containing a ferrous powder metal and a plurality of shot beads, the solidification assistant being in an amount of 2 to 30 wt%, the shot waste being in an amount of 5 to 25 wt%, and the briquette further containing ferrous-metal cutting residue particles and oil." Applicant respectfully submits that this combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Strange, Hattori, and Ishihara.

In particular, because independent claim 1 has been amended to include the subject matter of claims 4 and 5, the rejections of claims 1-3 as being anticipated by Strange, and claims 4 and 6 as being unpatentable over Strange in view of Hattori are mooted.

Applicant respectfully submits that Strange is directed to a briquette that is composed of 50% metallic fines, 41% mill scale, 2% bentonite, 3% pitch residue, 2% burnt lime fines, and 2% molasses. See abstract. Strange further states that "[t]hese percentages may be varied somewhat depending upon variations in the characteristics of the ingredients." See col. 2, lines 7-9. As a result, "[t]he novel briquettes so fabricated have been demonstrated to have excellent green strength so as not to fragment or dust off during handling, and by analysis contain about 80% iron." See col. 3, lines 14-17.

In contrast, as set forth in independent claim 1, the claimed briquette contains "solidifying shot waste with a solidification assistant, the shot waste containing a ferrous powder metal and a plurality of shot beads, . . . , the shot waste being in an amount of 5 to 25 wt%." As a result, the

briquette has adequate bulk density (0.2 on more) and mechanical strength. See paragraph [0030] of the present application.

Applicant respectfully submits that the amount of shot waste set forth in independent claim 1 is significantly different to that set forth in Strange. Moreover, Applicant respectfully submits that Ishihara does not teach or suggest the claimed range for the shot waste.

In particular, while Ishihara indicates that recovery dust S may be 10 to 55 wt% of iron, the briquette of Ishihara is not formed from just recovery dust S. Rather recovery dust S is part of a composition that includes brittle compact C, coke K, and solidification assistant D. See paragraph [0058]. In particular, the composition is 50 to 70 wt% of brittle compact C, 5 to 50 wt% coke K, 10 to 30 wt% of the recovery dust S, and 1 to 10 wt% of solidification assistant. See paragraph [0058]. And compact C is formed of cotton-like aggregates B of grinding chips produced by machining an "iron-based metal." See paragraph [0040]. Therefore, the cited range of 10 to 50 wt% of Fe is not indicative of the total amount of iron in the briquette. Accordingly, it can not be relied on as teaching the claimed amount of shot waste as required by independent claim 1.

Therefore, even in one of ordinary skill in the art were to modify Strange in view of Ishihara, the hypothetical combination would fail to render independent claim 1 obvious. Similarly, because Ishihara fails to show or describe the claimed amount of shot waste, and one of ordinary skill in the art would not look to Strange, which teaches at least 50 % metallic fine, to provide the claimed amount of shot waste, the hypothetical combination of Ishihara and Strange would fail to render independent claim 1 obvious.

Applicant respectfully submits that the combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Strange, Hattori, and Ishihara, for the reasons explained above. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

With regard to dependent claims 2, 6, and 7, Applicant submits that claims 2, 6, and 7 depend, either directly or indirectly, from independent claim 1, which is allowable for the reasons set forth above, and therefore claims 2, 6, and 7 are allowable based on their dependence from claim 1. Reconsideration and allowance thereof are respectfully requested.

**Additional Cited References**

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

**CONCLUSION**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone James T. Eller, Jr., Registration No. 39,538, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: January 21, 2009

Respectfully submitted,

By 

Paul C. Lewis

Registration No.: 43,368

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

CDW